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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,449	04/19/2000	Nancy Bryant	CIT10218	3842
27510 7590 10/23/2007 KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 10/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/553,449

Applicant(s)

BRYANT ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicants' communication filed on July 27, 2007. Amendments to claims 1 and 27, cancellation of claim 28 and addition of claim 29 have been entered. Claims 1-27 and 29 are pending in the application and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-27 and 29 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-27 and 29 are drawn to "a computer-implemented method, a computer system and a machine-readable medium for a user to obtain international account products access on a network". As such the claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception because the claims do not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result. The limitations of the method and the system including the last step of "allowing the user at the local terminal to perform said selected transaction interactively in said selected language via the host processor" do not produce any real world useful result. Allowing the user to perform

said selected transaction does not mean that the selected transaction is actually performed.

Allowing merely provides the ability to the user to perform a transaction but does not necessarily result in the user performing the transaction. Hence there is no real world useful result produced by implementing the steps of the claimed invention.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways: (a) The claimed invention “transforms” an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107.

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application”). The limitations of the method and the system including the last step of “allowing the user at the local terminal to perform said selected transaction interactively in said selected language via the host processor”

do not produce any real world useful result. Allowing the user to perform said selected transaction does not mean that the selected transaction is actually performed. Allowing merely provides the ability to the user to perform a transaction but does not necessarily result in the user performing the transaction. Hence there is no real world useful result produced by implementing the steps of the claimed invention.

For an invention to produce a “concrete” result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable. The steps of the claim including “allowing the user at the local terminal to perform said selected transaction interactively in said selected language via the host processor” does not produce useful, concrete and tangible result. Allowing merely provides the ability to the user to perform a transaction but does not necessarily result in the user performing the transaction.

Also in claims 1-27 and 29, it is not clear what useful, concrete and tangible result is produced if the condition “if a non-local user account type is identified, establishing a real-time interactive session directly between the user at the local terminal and a host processor” is not satisfied.

There is no useful, concrete and tangible result produced from implementing the steps of the claimed invention. The dependent claims are rejected for the same reason and by way of dependency on a rejected independent claim.

Claim Rejections - 35 USC § 112

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1-27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-27 and 29 recite the limitations “allowing a user to access a local terminal” and “allowing the user at the local terminal to perform said selected transaction interactively in said selected language via the host processor”. It is not clear what the outcomes of these steps are. These are not positive recitations because “allowing” does not imply that the act is performed but only that the user has the capability to do so. For instance allowing a user to access a local terminal does not necessarily result in a user accessing a local terminal. Appropriate correction/clarification is required. Claims 2-26 are rejected by dependency.

Claims 1, 27 and 29 recite the limitations “receiving the user’s selection of a language”, “receiving the user’s input of said access code” and “receiving the user’s selection of a transaction”. These limitations have no antecedent basis. Specifically the steps of the user selecting a language, the user inputting an access code and the user selecting a transaction have not been positively recited in the preceding steps. Appropriate correction/clarification is required. Claims 2-26 are rejected by dependency.

Also in these claims it is not clear as to what is the relationship between the steps of “allowing a user to access a local terminal” and “identifying a type of user account”. Is the second step based on the first step or is the identifying step performed independent of a user accessing the terminal. Hence the scope of the claim is not clear. Similar structural relationships

relating the steps/elements of the claim are missing in these claims. Also it is not clear as to what happens if a non-local user account type is not identified. Is the step of “automatically presenting a list of language options” performed regardless of whether a non-local user account type is identified or is not identified. Hence the scope of the claim is not clear. Appropriate correction/clarification is required.

Claims 1, 27 and 29 recite in the preamble “A method/system/machine-readable medium for a user to obtain international account products access on a network”. However there is no mention of any international account products in the body of the claim. It is not clear how the objective, set forth in the preamble, is accomplished by the body of the claim. Appropriate correction/clarification is required. Claims 2-26 are rejected by dependency on a rejected independent claim.

Response to Arguments

6. In response to Applicant’s arguments that “With all due respect, the Examiner should know that U.S. patent law does not require that all possible elements be listed in the patent, let alone listed in the claims”, the examiner would like to respectfully point out that the examiner is aware of the U.S. patent law. The claims rejected under 35 USC 101 are interpreted in view of 35 U.S.C. 112, second paragraph rejections discussed above. 35 U.S.C. 112, second paragraph requires that “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention”. While it is not required to list all possible elements in a claim, it is important to recite the elements so that there is no ambiguity about how the steps of the method are applied in the claimed invention. For instance if a local user account type is identified the method stops with the second step of the

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claimed invention, which is identifying a type of user account. This does not yield any useful, concrete and tangible result. In response to applicant's arguments that the invention achieve a "practical and useful result: providing global computer banking access in a variety of languages to traveling customers who require access to accounts when away from their home financial institutions and beyond the local regional financial area", the examiner respectfully disagrees. For example, providing access is not the same as performing a transaction. Allowing someone to use a computer to process information is not the same as processing information. No concrete, useful and tangible result is produced by allowing someone to access a computer. However concrete, useful and tangible result may be produced by processing information after accessing the computer. Hence the rejections made under

In response to Applicant's arguments that "The Examiner's claim that receiving the user's selection of a language by the host processor, receiving the user's input of an access code by the host processor, and receiving the user's selection of a transaction by the host processor have no antecedent basis in the claims is simply wrong. As previously pointed out, U.S. patent law does not require that all possible elements be listed in the patent, let alone listed in the claims, and the Examiner has cited no authority whatsoever in support of the Examiner's proposition that the claims must recite the user as a claim element because no such authority exists. The Examiner simply has no authority to mandate the addition of such elements.

Regarding the Examiner's claim that it is not clear from allowing a user to access a local terminal and identifying a type of user account what happens if a non-local user account type is not identified, again with all due respect, the Examiner has cited no authority allowing the Examiner to mandate addition of elements to cover conditions not necessary for the claimed

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method and system because no such authority exists, and the Examiner has no authority to mandate the addition of such elements.”, the examiner respectfully disagrees. 35 U.S.C. 112, second paragraph requires that “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention”. While it is not required to list all possible elements in a claim, it is important to recite the elements so that there is no ambiguity about how the steps of the method are applied in the claimed invention. For instance, is the step of identifying a type of user account based on the step of allowing a user to access a local terminal or is the identifying step performed independent of a user accessing the terminal. Hence the scope of the claim is not clear. Similar structural relationships relating the steps/elements of the claim are missing in these claims. Also it is not clear as to what happens if a non-local user account type is not identified. Is the step of “automatically presenting a list of language options” performed regardless of whether a non-local user account type is identified or is not identified. Hence the scope of the claim is not clear.

Applicant's other arguments with respect to pending claims 1-27 and 29 have been considered but are not persuasive.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached at (571) 272-6771. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian
Primary Examiner
Art Unit 3691

October 14, 2007